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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,939	01/11/2002	Lisa Dhar	495812001900	9372

20872 7590 10/20/2005
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,939

Applicant(s)

DHAR ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19, 40-48 and 50-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19, 40-48 and 50-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The prior rejection is withdrawn due to applicant's arguments. A new ground of rejection is presented below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-19, 40-48, and 50-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 70-78, 81, and 108 of copending Application No. 09/935,462 in view of USPN 5,466,319 to Zager et al.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Application '462 claims "an article", however, "an article" is construed as the instant application's "a third substrate" and the instant claims include a reflective layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-19, 40-48, and 50-53 are directed to an invention not patentably distinct from claims 70-78 and 108 of commonly assigned Application No. 09/935,462. Specifically, Application '462 claims "an article", while the instant application claims "a third substrate". Further the instant claims also include a reflective layer. Application '462 teaches a diffraction or relief pattern on the first substrate (instant claim 40) via embossing for creating track patterns in optical storage data mediums (Dhar, [0075]). See patented claims 70-81 to teaching the materials and structure of claims 11-19, 40-48, and 50-53. See [Dhar, 0079] to teaching the adherent capable of holographic data storage when the adherent used is a photopolymer material. While the preamble of claim 40 is to a multilayer reflective holographic storage system, the same layers, materials, and values are taught and thus a different naming of the essential elements do not make the product different.

While Application '462 does not expressly state the relief pattern is reflective, Zager teaches embossing a reflective relief pattern using a reflective aluminum layer for encoding purposes in laser playbacks for data storage in optical recording mediums of polycarbonate/glass substrates and photocurable layers (Zager, Abstract, col. 4, lines 45-55, col. 9, lines 27-40, col. 13, lines 55-65).

Thus, it would have been obvious to one having ordinary skill in the art to have modified Application '462 to have included a reflective layer because Zager teaches embossing a reflective relief pattern using a reflective aluminum layer for encoding purposes in laser playbacks for data storage in optical recording mediums of polycarbonate/glass substrates and

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photocurable layers (Abstract, col. 4, lines 45-55, col. 9, lines 27-40, col. 13, lines 55-65 of Zager).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-19, 40-48, and 50-53 are rejected under 35 U.S.C. 103(a) as being obvious over US Patent Application Publication 2003/0044576 A1 to Dhar et al. in view of UPSN 5,466,319 to Zager et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in

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accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Dhar teaches a system comprising a first and second substrate and an article located between the first and second substrate having the same adherent between the substrates. See patented claims 71 and 81 teaching all the limitations to the flatness and waviness requirements and Strehl value. While Application '462 claims "an article", the article is a polarizer located between first and second substrate and functions as the instant Application's "a third substrate". Application '462 teaches a diffraction or relief pattern on the first substrate (instant claim 40) via embossing for creating track patterns in optical storage data mediums (Dhar, [0075]). See patented claims 70-81 to teaching the materials and structure of claims 11-19, 40-48, and 50-53. See [0079] to teaching the adherent capable of holographic data storage when the adherent used is a photopolymer material. While the preamble of claim 40 is to a multilayer reflective holographic storage system, the same layers, materials, and values are taught and thus a different naming of the essential elements do not make the product different.

While Application '462 does not expressly state the relief pattern is reflective, Zager teaches embossing a reflective relief pattern using a reflective aluminum layer creating track patterns for encoding purposes in laser playbacks for optical recording data storage mediums of polycarbonate/glass substrates and photocurable layers (Zager, Abstract, col. 4, lines 45-55, col. 9, lines 27-40, col. 13, lines 55-65).

Thus, it would have been obvious to one having ordinary skill in the art to have modified Application '462 to have included a reflective layer because Zager teaches embossing a

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reflective relief pattern using a reflective aluminum layer for encoding purposes in laser playbacks for data storage in optical recording mediums of polycarbonate/glass substrates and photocurable layers (Abstract, col. 4, lines 45-55, col. 9, lines 27-40, col. 13, lines 55-65 of Zager).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Dhar is still used to essentially teach the same structure. Zager is used to show relief patterns are made reflective for reasons set forth above.

References of Interest

The remaining references listed on form(s) 892 and/or 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

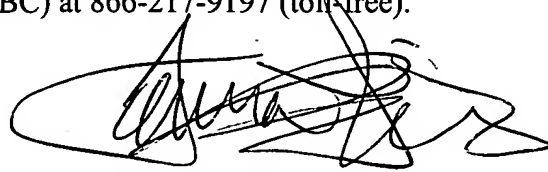
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

October 12, 2005



RENA DYE
SUPERVISORY PATENT EXAMINER

A.O. 1774 PH/05